

Serial No. 748,591

of such amendment, the accompanying Declaration and the following comments. The preceding amendments were not previously made because they were not regarded as required by present practice, and no authority for the rejection of claims 22 and 23 were provided by the PTO. The amendment is made at this time to eliminate an outstanding issue and thus place the application in better condition for allowance and/or appeal.

In addition to the foregoing, this paper was not previously filed because the comparative test data in the accompanying Declaration had not earlier been available to undersigned counsel.

Although the cover sheet of Paper No. 8 states that claim 23 has been withdrawn from consideration, Applicants respectfully note that such claim has, in fact, not been withdrawn and is expressly acted upon in Paper No. 8. Claim 23 defines a combination (a composition) which relies for patentability on a subcombination (the composition of claim 22 and/or the compound of claim 21). Please note the penultimate paragraph on page 4 of Applicants' Amendment of September 10, 1986, and the quotation from the MPEP at the end of page 2 of Paper No. 6. The very guidelines relied upon for restriction (with regard to claim 23) establish that such

Serial No. 748,591

restriction is directly contrary to prevailing practice. Reconsideration and withdrawal of the requirement with regard to claim 23 are thus clearly in order and are respectfully solicited.

The rejection of claims 1 to 19, 21, 22, 24 and 25 to 27 "under 35 USC 103 as being unpatentable over patent 4,555,518 or 4,560,693 in view of 4,255,431" is respectfully traversed. In support of the patentability of all asserted claims over applied art, reference is respectfully made to the accompanying Declaration under Rule 132. This Declaration provides extensive comparative test data establishing clearly unexpected properties of compounds to which the instantly-asserted claims are limited, when compared with their closest respective counterparts in the art relied upon. As pointed out in the third complete paragraph on page 2 of the specification, an object of Applicants' invention "is to provide chemically-stable compounds and compositions...and especially to impart higher chemical stability to pyridyl sulfinyl benzimidazoles. The accompanying Declaration addresses the problem of chemical stability and the unexpectedly improved stability of compounds within the scope of instantly-asserted claims.

Such unexpectedly-improved stability is not in any way suggested by anything derived from applied art. Even when

Serial No. 748,591

claimed subject matter is clearly within a prior-art disclosed genus and claimed compounds may be regarded as structurally obvious from prior-art teachings, patentability can still be established by evidence that the specifically-claimed subject matter possesses clearly unexpected properties. In this regard reference is respectfully made to the opinion for *In re Petrzilka, Hofmann, Schenk, Troxler, Frey, and Ott*, 165 USPQ 327 (CCPA 1970), at 328:

Appellants' principal contentions are: ...and (2) assuming that a prima facie case of obviousness has been made out, that Appellants have shown that their compound possesses such unexpected properties in comparison to reserpine as to rebut obviousness under the statute. Inasmuch as we agree with Appellants' second contention, we need not consider the first.

Selection inventions have long been recognized as capable of supporting valid patents. It is clear that none of the applied art either recognized or suggested the possibility of improving chemical stability in the manner discovered by Applicants.

Issue is respectfully taken with the allegation: "Junggren et al. enables one skilled in the art to make the di- or tri-alkoxy substituted pyridyl moiety in the claimed compounds." Even if no weight is given to the argument set forth in the first complete paragraph on page 6 of Applicants' response of September 10, 1986, or

Serial No. 748,591

to the second complete paragraph on page 22 of Applicants' specification, which points out the novelty of intermediates, the PTO has failed to establish that required intermediates were known. Moreover, even were such intermediates well known, the accompanying Declaration more than adequately establishes patentability.

The rejection of claims 1 to 19, 21, 22 and 24 to 27 "under the judicially created doctrine of obvious-type double patenting is respectfully traversed in the same manner and for the same reasons as discussed in connection with the preceding prior-art-based ground of rejection. Applicants respectfully submit that the accompanying evidence, by itself, should be more than adequate to overcome this ground of rejection entirely.

The rejection of claims 1 to 19, 21, 22 and 24 to 27 "under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of co-pending application SN 794,230" is also respectfully traversed. Applicants respectfully submit that the Statement of August 22, 1986, filed on their behalf on September 10, 1986, is more than

Serial No. 748,591

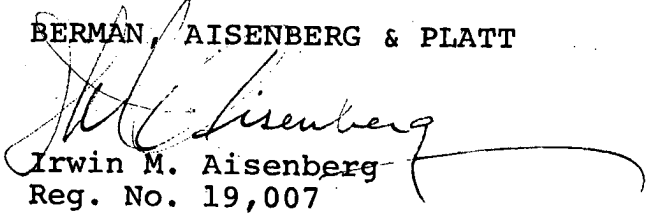
adequate to overcome this ground of rejection. Applicants further understand from a discussion with Examiner Fan on November 25, 1986, that the noted Statement serves its intended purpose in this regard.

The rejection of claims 22 and 23 "under 35 USC 112, first and second paragraphs" is also respectfully traversed. The sole basis for this ground of rejection found in Paper No. 6 is that set forth in paragraph 2 (page 7) of that Office Action. Both of these claims have now been amended to recite "an intended use", even though no authority has been provided in support of the adverse holding, and current practice clearly confirms the propriety of these claims. Composition claims (lacking any statement with regard to intended use) are regularly issued by the PTO. Support in this regard is provided by Aisenberg's "Attorney's Dictionary of Patent Claims", Volume 1, pages C-52.1 to C-55 (copy herewith), Matthew Bender, 1986.

Having overcome all outstanding grounds of rejection, an early notice of allowance is respectfully solicited.

Respectfully submitted,

BERMAN, AISENBERG & PLATT


Irwin M. Aisenberg
Reg. No. 19,007

1730 Rhode Island Avenue, N.W.
Washington, D. C. 20036-3186
(202) 293-1404